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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,721	12/28/1999	DIETER PELZ	202531	6319

7590 06/17/2003

LEYDIG VOIT & MAYER
TWO PRUDENTIAL PLAZA
180 NORTH STETSON
SUITE 4900
CHICAGO, IL 606016780

EXAMINER

SHERRER, CURTIS EDWARD

ART UNIT	PAPER NUMBER
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1761

18

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 18

Office Action Summary

Application No.

09/402,721

Applicant(s)

PELZ ET AL.

Examiner

Curtis E. Sherrer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/08/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7-18, 20-22, 24-33, and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-18, 20-22, 24-33 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 7-18, 20-22, 24-33, and 36-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because the scope of the phrase "about" is unknown. Applicants refer to case law that states, "it is rarely feasible to attach a precise limit to 'about'" except when the technology is like that in discussed in *Modine*. Applicants do not state what that technology embodied and therefore it is not clear that *Modine* is relevant. Similarly, *Pall* states that said term must be interpreted in light of the technologic and stylistic context." In conclusion, applicants have not supplied the necessary specificity to needed to fully understand the scope of the term "about."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-15, 18, 20-22, 27, 28, 31, 33 and 37-42 are rejected under 35 U.S.C.

103(a) as being unpatentable over Fuji in view of applicants' admissions.

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Applicants argue that Fuji does not mention beer in its teachings. Applicants are reminded that the instant rejection is based on a combination of teachings and applicants themselves have admitted that filtering beer is notoriously well known.

Applicants also argue that Fuji defines "enzyme" in the plural rather than singular but do not provide any convincing basis for such an argument. Fuji refers to the two enzymes in the alternative, i.e., "and/or." This is interpreted as a proteolytic enzyme **or** a cellulase-destroying enzyme. Fuji, therefore, contemplates using cellulase in the absence of a protease.

Applicants, for the first time, argue that because the prior art does not teach the crystalline: soluble cellulase activity, that the dependent claim 4 and those that depend therefrom, are not obvious in view of the prior art. Applicants have not seasonably traversed the well known statement during examination, and therefore the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). Applicants are charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. See MPEP § 2144.03.

Claims 16-17, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji in view of applicants' admissions and in further view of (pages 1-3 of instant application) and in further view of Ebara (JP Pat. No. 52122281) for the reasons set forth in the last Office Action.

Claims 26, 29, 30, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji in view of applicants' admissions and in further view of Bolay *et al.* (Jnl. of Colloid

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and Interface Sci.)(hereinafter "Bolay") instant application)(hereinafter Bolay) for the reasons set forth in the last Office Action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis E. Sherrer whose telephone number is 703-308-3847. The examiner can normally be reached on Tuesday-Friday, 8AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Curtis E. Sherrer
Primary Examiner
June 13, 2003